



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,084	08/09/2001	Gil Tenne	U 013591-0	4110
140	7590	11/21/2006	EXAMINER	
LADAS & PARRY 26 WEST 61ST STREET NEW YORK, NY 10023			HINES, JANA A	
			ART UNIT	PAPER NUMBER
			1645	

DATE MAILED: 11/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/927,084

Applicant(s)

TENNE ET AL.

Examiner

Ja-Na Hines

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 36-63 is/are pending in the application.
4a) Of the above claim(s) 1-15 and 36-41 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 42-63 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Amendment Entry

1. The amendment filed July 17, 2006 has been entered. The examiner acknowledges the amendments to the specification. Claims 1-15 and 36-41 have been withdrawn from consideration. Claims 16-35 have been cancelled. Claims 42-63 have been newly added and are under consideration in this office action.

Withdrawal of Rejections

2. The following rejections have been withdrawn in view of applicants' amendments and arguments:

- a) The scope of enablement rejection of claims 16-35 under 35 U.S.C. 112, first paragraph;
- b) The deposit rejection of claim 33 under 35 U.S.C. 112, first paragraph;
- c) The rejection of claims 16-35 under 35 U.S.C. 112, second paragraph; and
- c) The rejection of claims 16-32 and 34-35 under 35 U.S.C. 102(b) as being anticipated by Karapetian (US Patent 5,344,762).

Response to Arguments

3. Applicant's arguments filed July 25, 2003 have been fully considered but they are not persuasive. The arguments have been addressed below along with the new grounds of rejection.

New Grounds of Objection and Rejection

Claim Objections

4. Claim 57 is objected to because of the following informalities: The claim states "Enterococcus^{sp}". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. The rejection of claims 42-63 under 35 U.S.C. 112, second paragraph; and as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claim 42 recites the limitation "a corresponding sample" in the claim. There is insufficient antecedent basis for this limitation in the claim. It is unclear what the corresponding sample is; i.e., whether it is a duplicate sample or a control sample. It is unclear where the corresponding sample came from. Therefore the claim is rejected.

Applicants assert that page 6, lines 13-15 states that the corresponding sample for instance can be a second sample treated in the same manner. However this example of a corresponding sample does not provide a definition of a corresponding sample. The claims are held to be indefinite because the specification lacks some standard for determining the degree of correspondence intended. Therefore, the claims are rejected as being indefinite.

Art Unit: 1645

b) Dependant claims 44-45 refer to "A method", however the suggested claim language is to use of the article "The." Therefore the suggested claim language is "The method."

c) Claim 45 recites alternative limitations which are improperly expressed. Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. One acceptable form of alternative expression, which is commonly referred to as a Markush group recites members as being "selected from 1, 2, 3, or 4." Applicant may correct this by amending the claim to recite the appropriate alternative language.

d) Claim 56 recites alternative limitations which are improperly expressed. Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. One acceptable form of alternative expression, which is commonly referred to as a Markush group recites members as being "selected from the group consisting of A, B and C". Applicant may correct this by amending the claim to recite the appropriate language.

e) Claim 60 recites the phrase "a standard culture of cancer cells". The term in the claims is a relative term that renders the claim indefinite. For instance, the claims are indefinite because it is unclear what makes the cancer cells standard. It is unclear what attributes must the cancer cells possess to be deemed standard. The term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of

Art Unit: 1645

the scope of the invention. The metes and bounds of the term cannot be ascertained and clarification is required to overcome the rejection.

Applicants' assert that the phrase is well understood to by one of ordinary skill in the art. However, applicants' mere assertions about what is understood by those of ordinary skill in the art are not sufficient to overcome the rejection. Therefore appears to be no basis for applicants' assertions. Thus the claim is indefinite because the specification lacks some standard for determining a standard culture of cancer cells.

f) Claim 61 recites the limitation "the accession". There is insufficient antecedent basis for this limitation in the claim. Appropriate clarification is required.

g) Claim 62 recites the limitation "said mixture". There is insufficient antecedent basis for this limitation in the claim. Appropriate clarification is required.

h) Claim 63 recites the limitation "the number of interacted and/or non-interacted cancer cells". There is insufficient antecedent basis for this limitation in the claim. Appropriate clarification is required.

Conclusion

6. No claims allowed.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ja-Na Hines whose telephone number is 571-272-0859. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Jeffery Siew, can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1645

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ja-Na Hines 
November 15, 2006


MARK NAVARRO
PRIMARY EXAMINER